

**Appl. No.** : **10/694,510**  
**Filed** : **October 27, 2003**

## **REMARKS**

The foregoing amendments and the following comments are responsive to the objections and rejections set forth by the Examiner in the January 31, 2007 Office Action.

Claims 9-15, 21-23, 25, 27, and 29-36 are pending in this application. The Examiner rejected Claims 9-15, 21-23, 25, 27, and 29-36. In particular, the Examiner rejected Claims 9-11, 13-15, 21-23, 25, 27, 29-31, and 33-36 under 35 U.S.C. § 102(e) as being anticipated over U.S. Patent No. 6,770,070 ("the Balibierz '070 patent"). The Examiner rejected Claim 12 under 35 U.S.C. § 103(a) as being unpatentable over the Balibierz '070 patent in view of U.S. Patent No. 6,669,708 ("the Nissenbaum et al. '708 patent"). The Examiner further rejected Claim 32 under 35 U.S.C. § 103(a) as being unpatentable over the Balibierz '070 patent in view of U.S. Patent No. 6,319,246 ("the De la Torre et al. '246 patent"). In view of the following discussion, reconsideration of the application is respectfully requested.

### **REJECTION OF CLAIMS 9-11, 13-15, 21-23, 25, 27, 29-31, and 33-36 UNDER 35 U.S.C. § 102(e)**

The Examiner rejected Claims 9-11, 13-15, 21-23, 25, 27, 29-31, and 33-36 under 35 U.S.C. § 102(e) as being anticipated over U.S. Patent No. 6,770,070 ("the Balibierz '070 patent").

#### **Claims 9, 21, and 34**

Balibierz '070 appears to disclose a lung biopsy catheter, with a sharp distal end configured to punch a hole in the lung and take a sample of lung tissue. The catheter appears to be further configured to seal a hole in the lung by delivering a plug, energy, or other sealing material. Ports appear to be provided for aspiration of a lung biopsy sample.

The Balibierz '070 disclosure does not appear to disclose a cannula specifically designed not to penetrate the lung, heart, or other organ tissue and provide for drainage of fluid from the region outside the lung but within the thoracic cavity. The

apparatus and method of Balibierz '070 does not appear to include provision for a drainage lumen for removal of fluid and debris from the region around the lung.

In contrast in an embodiment of the invention, a method of draining of fluid, air and contaminants from a thoracic cavity of a mammalian patient comprises inserting a tapered, blunt tip of a flexible trocar and a distal end of an axially elongate tube into an incision into a thoracic cavity of a mammalian patient, wherein the flexible trocar is pre-inserted through a drainage lumen of a bidirectional, non-removable valve attached to a proximal end of the axially elongate tube and through a drainage lumen of the axially elongate tube and extends substantially the length of the axially elongate tube, selectively bending a region near the distal tip of the axially elongate tube while advancing the axially elongate tube into the thoracic cavity, wherein the bending steers the axially elongate tube into the thoracic cavity during insertion, removing the flexible trocar through the valve from the drainage lumen of the axially elongate tube and the drainage lumen of the valve, and selectively opening or closing the valve to control influx and efflux of fluid, air or contaminants into the thoracic cavity through the drainage lumen of the axially elongate tube.

Because the reference cited by the Examiner does not disclose, teach or suggest a method of draining fluid, air and contaminants through the drainage lumen of a chest tube, the chest tube, the chest tube being steerable or introduced over a guidewire, Applicants assert that Claims 9, 21, and 34 are not anticipated Erickson. Applicant therefore respectfully submits that Claims 9, 21, and 34 are patentably distinguished over the cited references and Applicant respectfully requests allowance of Claim 9, 21, and 34.

#### **Claims 10, 11, and 13-15**

Claim 10 and 11, which depend from Claim 9, are believed to be patentable for the same reasons articulated above with respect to Claim 9, and because of the additional features recited therein.

**Appl. No.** : **10/694,510**  
**Filed** : **October 27, 2003**

**Claims 22, 23, 25, 27, 29-31, 33, 35, and 36**

Claims 22, 23, 25, 27, 29-31, 33, 35, and 36, which depend from Claim 21, are believed to be patentable for the same reasons articulated above with respect to Claim 21, and because of the additional features recited therein.

**REJECTION OF CLAIM 12 UNDER 35 U.S.C. § 103(a)**

The Examiner rejected Claim 12 under 35 U.S.C. § 103(a) as being unpatentable over the Balibierz '070 patent in view of U.S. Patent No. 6,669,708 ("the Nissenbaum et al. '708 patent").

**Claim 12**

Claim 12, which depends from Claim 9, is believed to be patentable for the same reasons articulated above with respect to Claim 9, and because of the additional features recited therein.

**REJECTION OF CLAIM 32 UNDER 35 U.S.C. § 103(a)**

The Examiner rejected Claim 32 under 35 U.S.C. § 103(a) as being unpatentable over the Balibierz '070 patent in view of the De la Torre et al. '246 patent.

**Claim 32**

Claim 32, which depends from Claim 21, is believed to be patentable for the same reasons articulated above with respect to Claim 21, and because of the additional features recited therein.

Appl. No. : 10/694,510  
Filed : October 27, 2003

**CONCLUSION**

In view of the forgoing, the present application is believed to be in condition for allowance, and such allowance is respectfully requested. If further issues remain to be resolved, the Examiner is cordially invited to contact the undersigned such that any remaining issues may be promptly resolved.

Respectfully submitted,

Dated: 27 April 2007

By: Jay A. Lenker  
Jay A. Lenker  
(949) 494-3645  
(949) 322-6929 (Mobile)